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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/707,137

11/21/2003

Mark C. Block

1136

39485

7590

04/28/2005

MARK C. BLOCK

P.O. BOX 1721

ESTES PARK, CO 80517

EXAMINER

STULTZ, JESSICA T

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/707,137

Applicant(s)

BLOCK, MARK C.

Examiner

Jessica T. Stultz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1103</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

Color photographs and color drawings are not accepted unless a petition filed under 37 CFR 1.84(a)(2) is granted. Any such petition must be accompanied by the appropriate fee set forth in 37 CFR 1.17(h), three sets of color drawings or color photographs, as appropriate, and, unless already present, an amendment to include the following language as the first paragraph of the brief description of the drawings section of the specification:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

Color photographs will be accepted if the conditions for accepting color drawings and black and white photographs have been satisfied. See 37 CFR 1.84(b)(2).

Claim Objections

Claim 1 is objected to because of the following informalities: "comprising of:" should be "comprising:". Appropriate correction is required.

Claim 1 recites the limitation "in front of the customer" in the claim. There is insufficient antecedent basis for this limitation in the claim. Specifically, there is no previous mention of a customer in the claim. The assumed meaning for purposes of examination is "in front of a customer".

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 1 is rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

Specifically, that part of the claim stating “a novel promotional and advertising item” includes language that is inconsistent with acceptable claim language since any invention is considered “novel” and it is not necessary to reiterate this language in the claim. For examination purposes, the assumed meaning is “a promotional and advertising item”.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase “may utilize” renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Specifically it is not clear from the phrase “item that a business or establishment may utilize” whether or not the business is required to utilize the item. For examination purposes, the assumed meaning is “item for a business or establishment”.

Regarding claim 1, the phrase “can be conveniently attached” renders the claim indefinite because the term “conveniently” is not directed to the structure of the product and therefore does

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not place a further limitation on the claim. See MPEP § 2173.05(d). For examination purposes, the assumed meaning is “can be attached”.

Regarding that part of the claim stating, “wherein the pocket identifies to the customer the availability of the lens for complementary present and future use” does not specifically disclose a further limitation of the structure of the pocket. This phrase is directed to a method of using the pocket wherein the pocket is used to identify the lens availability to the customer and would be more appropriate in a method claim rather than a product claim. From what is disclosed in the specification, the assumed meaning for purposes of examination is “wherein the pocket includes a clear portion through which the lens can be seen”.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 rejected under 35 U.S.C. 103(a) as being unpatentable over Giampavolo et al in view of Taylor.

Regarding claim 1, Giampavolo et al discloses a promotional and advertising item for a business to keep their name in front of a customer (Column 1, line 66-Column 2, line 10, wherein the advertising item is label enlarging device “10”, which includes advertising material on the frame “30”, Figure 1) comprising: a disposable flat-sheet wallet-sized magnifying lens (Column 1, line 66-Column 2, line 10, wherein the flat-sheet magnifying lens is “26” which is wallet sized and can be thrown away, i.e. disposable, Figures 1 and 3-5), with promotional

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indicia printed around the frame holding the lens (Column 1, line 66-Column 2, line 10, wherein the advertising item is label enlarging device "10", which includes advertising material on the frame "30" of the lens, Figure 1); wherein the lens may be retained by the customer until scratched, worn, or lost (Column 1, line 66-Column 3, line 14, wherein the lens is mounted in a device "10" which is removably attached from the shelving "24" and may therefore be retained by the customer); and a self-adhesive pocket that can be attached to a device to hold the magnifying lens and all future replacements (Column 1, line 66-Column 23, line 14, wherein the lens is held in a frame "28", which is attached to shelving "24", i.e. self-adhesive, to read small printing on products, wherein the lens can be replaced if needed, Figures 1-5), wherein the pocket includes a clear portion through which the lens can be seen (Column 1, line 66-Column 23, line 14, wherein the lens is held in a frame "28" through which the lens can be seen, Figures 1-5), but does not specifically disclose that the pocket is specifically used to read a menu or that the promotional indicia is printed around the peripheral edges of the lens. However it would have been obvious to attach the pocket to a menu since the pocket is removable and could be attached to any device, such as a menu to magnify the words on the menu. Regardless, Taylor teaches of a magnifier used to read a menu (Column 2, line 54-59 and Column 4, lines 49-60, wherein the magnifying lens "24" is used to read menus) wherein the lens includes promotional indicia printed around the peripheral edges of the lens (Column 4, line 61-Column 5, line 10, wherein the lens includes indicia "27" which may be printed directly on the lens, Figure 2A) for the purpose of magnifying the menu rather than printing all new menus with large print and to promote the restaurant's name (Column 2, line 54-59 and Column 4, line 49-Column 5, line 10). Therefore it would have been obvious to one having ordinary skill in the art at the time the

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invention was made for the lens of Giampavolo et al to further be used to read menus since Taylor teaches of a magnifier used to read a menu wherein the lens includes promotional indicia printed around the peripheral edges of the lens for the purpose of magnifying the menu rather than printing all new menus with large print and to promote the restaurant's name.

Examiner's Comments

For applicant's information, that part of the claim stating "wherein the lens may be retained by the customer until scratched, worn or lost" can be true of any device that is removable. Specifically, any removable promotional device can be retained by the customer for future use.

Conclusion

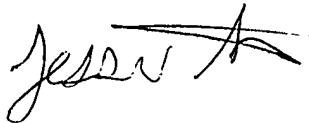
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hicks, Vogel, and Ward are cited as having some similar structure to the claimed invention. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica T. Stultz whose telephone number is (571) 272-2339. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on 571-272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jessica Stultz
Patent Examiner
AU 2873
April 21, 2005



JORDAN SCHWARTZ
PRIMARY EXAMINER